



Attorney's Docket No. 081468-0307393
Client Reference: P-1786.000-US

PATENT

Free

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Confirmation No.: 2880

BUTLER et al.

Application No.: 10/747,615

Group No.: 2851

Filed: December 30, 2003

Examiner: P. Kim

For: WIRELESS SIGNALING IN A LITHOGRAPHIC APPARATUS

REPLY TO ELECTION OF SPECIES REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Election of Species Requirement dated May 12, 2006, with respect to claims 1, 9, 16 and 17, Applicants provisionally elect Species I. With respect to claim 15, Applicants provisionally elect Species IV. These elections are made with traverse.

MPEP § 806.04(e) states: "Claims are definitions of inventions. *Claims are never species*. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a *generic or genus claim*). *Species are always the specifically different embodiments.*" (Italicized emphasis in original. Underlining emphasis added.)

As discussed in the previous reply, it is respectfully submitted that each of claims 1, 9, 15, 16 and 17 is a generic or genus claim as each claim includes within its breadth and scope two or more of the disclosed embodiments. As also discussed in the previous reply, Applicants respectfully disagree that claims 1, 9, 15, 16 and 17 contain the "species" identified by the Examiner. The claims cover the individual

elements recited and the combinations thereof covered by the “at least one of” language recited in each claim.

MPEP § 806.01 states: “[A] provisional election of a single species may be required where only generic claims are presented and the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary.”

It is respectfully submitted that it is clear from the MPEP sections discussed above that the criteria for a serious burden applies regardless of whether the restriction (election of species) requirement is directed against the specifically different embodiments as defined by a plurality of specific species claims or against a generic or genus claim, or claims.

It is further respectfully submitted that the three “species” contained in claims 1, 9, 16 and 17, and the four “species” contained in claim 15 hardly represent such a multiplicity of species that an unduly extensive and burdensome search is necessary.

With respect to the Examiner’s determination that a burden exists because Applicants may delete a particular limitation and the Examiner must then start to search other areas, it is respectfully noted that MPEP § 904 states: “The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.” (Underlining emphasis added.)

It is also respectfully noted that MPEP § 904.02(a) states: “The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.”

Moreover, as noted in the previous reply, the Examiner has already searched and examined the entire application. MPEP § 811 states: “37 CFR 1.142(a), second sentence, indicates that a restriction requirement ‘will normally be made before any

action upon the merits; however, it may be made at any time before final action.' This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required."

Applicants originally presented claims 1, 9, 16 and 17 containing the three "species" identified by the Examiner. Applicants originally presented claim 15 containing the four "species" identified by the Examiner. The Examiner searched and examined claims 1, 9, 15, 16 and 17. In fact, the Examiner examined them twice, in the June 14 and October 19, 2005 Office Actions. Presumably, the Examiner followed the directives of MPEP Chapter 900, including the sections discussed above, in formulating and conducting the first search.

However, to the extent that it is now the position of the Examiner that the first search did not cover the invention as described and claimed, it is respectfully submitted that it is of no concern to Applicants. As discussed in the previous response, Applicants complied with the requirements of 35 U.S.C. § 112, 2nd paragraph and presented claims particularly pointing out and distinctly claiming the subject matter which they regard as their invention. If the Examiner chose to ignore the directives of MPEP § 904 and searched only a portion, or portions, of the subject matter covered by the claims, Applicants should not be disadvantaged by such action.

As discussed above with respect to MPEP § 806.01, Applicants are entitled to have their generic or genus claims (which claims 1, 9, 15, 16 and 17 are) searched and examined unless the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. It is again respectfully submitted that the three "species" covered by claims 1, 9, 16 and 17 and the four "species" covered by claim 15 hardly represent such an unduly extensive and burdensome search, particularly in light of the fact that all of the claims have been searched at least once and examined twice.

It is further respectfully submitted that the Examiner has not established that a serious burden exists. MPEP § 808.02 sets forth the criteria for establishing a serious burden. The Examiner's conclusion that the current rejections may be

overcome by “merely deleting” certain limitations is nothing more than speculation. The undersigned is not aware of any provision of the MPEP that permits the Examiner to establish a serious burden based on claim amendments Applicants might make. In addition, it is respectfully noted that in two previous replies, Applicants have not deleted any of the limitations directed to the “species” contained in claims 1, 9, 15, 16 and 17. Accordingly, the Examiner’s concern for what claim amendments Applicants may make is, at least to this point in the prosecution, unfounded.


Futhermore, Applicants are entitled by 35 U.S.C. § 132(a) and 37 C.F.R. § 1.111(a) to amend the claims in response to each Office Action. Under the Examiner’s theory, any claim amendment may result in a serious burden and a restriction requirement. Clearly that is not the intended scope of 35 U.S.C. § 132 and 37 C.F.R. § 1.111.

MPEP § 904 again provides guidance in this instance. As discussed above, MPEP § 904 states: “The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search.” As Applicants originally presented claims 1, 9, 16 and 17 containing the three “species” and originally presented claim 15 containing the four “species” and the Examiner searched the claims at least once, again presumably according to the directives of the MPEP, and examined them at least twice, it is respectfully submitted that the criteria for a proper restriction requirement has not been satisfied.

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Reconsideration and withdrawal of the election of species requirement are respectfully requested.

Respectfully submitted,
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